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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,714	02/06/2001	Gary M. Katz	PIP-69A-KATZ	2896
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NEIFELD IP LAW, PC 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			ALVAREZ, RAQUEL	
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			3622	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/776,714

**Applicant(s)**

KATZ, GARY M.

**Examiner**

Raquel Alvarez

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 59-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58, 62-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to communication filed on 10/7/2004.
2. Claims 47-65 have been added. Claims 1-65 are presented for examination.

### ***Election/Restrictions***

3. Newly submitted claims 59-61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: recite a vendor location site and a check-out counter located at the vendor's site.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-61 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C.

§101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-

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statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather

under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claim 1 recite a method and independent claim 28 recites a system (in "means plus function) language. Method claim 1 clearly recites a "useful, concrete and tangible result" ("determining a time at which a promotion is to be provided to a consumer"), however the claim recites no structural limitations (i.e., computer implementation), and so it fails the first prong of the test (technological arts). System claim 28 also clearly recites a "useful, concrete and tangible result" however, since the claim is in "means plus function" language, the specification must be consulted to determine the corresponding structure and equivalents thereof:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that

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the PTO should be. Thus, this court must accept the plain and precise language of paragraph six. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

When one looks to the specification to determine the corresponding structure, or equivalents thereof, for the “means” recited in claim 28, one finds the following “The present invention, in certain preferred embodiments, provides a method for presenting a selected offer to the associated individuals (i.e. not necessarily computer implemented).

From this it can be seen that the broadest reasonable equivalent disclosed (“by hand” or “manually transmission”) fails to pass the first prong technological arts test and therefore recites non-statutory subject matter under 35 USC 101.

### **Claim Rejections - 35 USC § 102**

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-5, 7, 9-21, 23-36, 39-42 and 44-46, 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Swix et al. (6,718,551 hereinafter Swix).

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3).

With respect to claims 4-5, Swix further teaches that one or more parameters related to said promotions received by said consumer relate to a product class/product industry of said promotions received by said consumer (Figure 3).

With respect to claim 16, Swix further teaches selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion (col. 12, lines 22-90).

With respect to claims 17-18, Swix further teaches selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile (col. 12, lines 22-60).

With respect to claims 26 and 44, Swix further teaches determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase characteristic of said consumer (col. 12, lines 22-60).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 22, 38, 47-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Swix.

Claim 6, 22, 38 further recites that the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer. Official



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notice is taken that it is old and well known for promotions to have a location in which it can be redeemed in order to promote patronage of an establishment. It would have been obvious a person of ordinary skill in the art at the time of Applicant's invention to have included the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer in order to obtain the above mentioned advantage.

Claims 8 and 37 further recites a promotion validity date. Official notice is taken that it is old and well known for offers to have a validity date in which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites a promotion validity date in order to obtain the above mentioned advantage.

Claim 43 further recites that the promotions have a time of receipt record. Official notice is taken that it is old and well known in the computer related arts to time stamp information received in order to keep track of when the information was received. It would have been obvious to a person of ordinary skill in the art at the time Applicant's invention to have included promotions time receipt record in order to obtain the above mentioned advantage.

Claims 47-58 recite well known forms and methods of distributing an offer and would therefore have been obvious to one of ordinary skill in the art to use such a known form of advertisement.

**Response to Arguments**

7. First of all, the 101 Rejection is still maintained as shown above. Furthermore, the Examiner has legal authority to raise such issues and make such a rejection. There is a plurality of legal precedents in the form of case laws to support the Examiner's position (See the 101 section above). The Applicant is once again being encouraged and advised to amend the claims so that the subject matter disclosed therein is statutory. Please, remember that the technology should be incorporated primarily in the body of the claims since the Examiner does not always give patentable weight to the preambles of the claims.

8. Applicant argues that Swiss doesn't teach identifying based upon said received identification information, one or more parameters related to promotions received by the customer. The Examiner disagrees with Applicant because Swiss teaches that the system identifies the person and the commercial or ad that the person has received (col. 12, lines 36-46).

9. Applicant argues that Swiss doesn't teach determining a time at which a promotion is to be provided based upon said identifies one or more parameters related to promotions received by said consumer. The Examiner disagrees with Applicant because Swiss teaches determining a time, such as when the user is watching a particular program in which to present to present further ads, based on the user's receipt of previous ads. For example, when a user is has watched/received a commercial for outdoor adventure gear then the system determines when is the right

time to display a commercial for a sport utility vehicle in which the user can carry out the adventure gear previously watched/received by the customer (col. 12, lines 43-60).

10. Applicant argues that Swiss doesn't teach that the promotions relate to the packaging of said received promotions. The Examiner disagrees with Applicant because Swiss relate the promotions to the nature of the received promotions (col. 12, lines 43-60).

11. Applicant argues that Swiss doesn't teach that the promotions received by the consumer relate to a product class/product industry. The examiner disagrees with Applicant because based on the ads received by the customer, for example, outdoor gear, a related product is selected and displayed to the consumer (col. 10, lines 43-67).

12. Applicant argues that Swiss doesn't teach selecting said promotion based on characteristics of the customer. The Examiner disagrees with Applicant because Swiss teaches using the event data of the customer to target the promotions (col. 10, lines 51- to col. 11, lines 1-2).

13. Applicant argues that Swiss doesn't teach that the promotion is based on demographic and purchase history of the customer. The Examiner disagrees with Applicant because Swiss on col. 6, lines 8-25, using the customer demographics and interactive purchasing pattern, to target the promotions.

14. With respect to the official notice taken by the Examiner that having a location at which to redeem an offer, for offers to have a validity date in which the offers can be redeemed, the promotions having a time stamp, Applicant asserts that Swiss does not teach, suggest, illustrate or enable either of the functions such functions and that is not

valid reasoning, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned

**Conclusion**

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
12/30/04